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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,539	12/14/1998	AKIRA ISHIBASHI		5289

7590

08/06/2003

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

25

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A 825

Office Action Summary

Application N .

09/210,539

Applicant(s)

ISHIBASHI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendment filed 4/46/02 is still objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure, for reasons cited in the previous Office action.

Claim Rejections - 35 USC § 102/103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, 5, 6, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., for reasons cited in previous Office actions.
4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obuchi et al. or Tsai et al., each independently as applied to claims 1, 2, 5, 6, 8 and 10-12 above, and further in view of Yamada et al., for reasons cited in previous Office actions.

Response to Arguments

5. Applicant's arguments filed 6/11/03 have been fully considered but they are not persuasive.

6. Regarding the new matter in the specification, applicant asserts that the amendment was to correct a translation error, but has not provided any evidence to support this statement, such as the original untranslated paragraph.

The examiner still contends that the subject matter in question is of such a substantial nature as to potentially distinguish one of the cited references from the present claims, that such substantial evidence is required.

7. Regarding the submission from the FBAW website, in applicant's argument, applicant states that these web pages state or make it clear that Bionolle #1020 does not contain talc. However, no such statement was found in these pages. The university website lists a general description of Bionolle #1020, along with other Bionolle grades. This is a general description, which is not a manufacture's technical disclosure describing the specifics of #1020 or the distinctions between the "1020" and the other Boinelles products (i.e., #3020, #1000, #3000, etc.). Applicant still has not provided such substantial evidence to demonstrate that applicant's Boinelle #1020, **contrary to applicant own description in the application as originally filed** is not a talc-containing polymer.

Applicant makes it clear in the original specifications that "Bionelle #1020", **the grade of Bionelle** used in the present invention **comprises 30% talc**. In page 36, lines 17-23 and col. 37, lines 3-7 of the present specifications, Applicant explicitly **defines** Bionelle 1020 as "commercially available . . . **talc-containing (30%) grade of th**

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aliphatic polyester type biodegradable resin made by Showa Highpolymer Co., Ltd and **sold under the trademark designation of 'Bionelle' #1020**". The Examiner still does not see how idiomatic errors alone can account for such distinction.

Further, if applicant wished to properly incorporate new matter, it is suggested that applicant file a C-I-P so as to allow such a change/addition.

8. Regarding the Declaration under 37 C.F.R. § 1.131 and invention reports (dated 9/17/97 and 10/31/97), without a single embodiment in either invention report disclosing the basic technical feature of the present invention, i.e., both the dispersed PLA and the dispersed inorganic filler in the polyester continuous phase, the Declaration is not persuasive. Several prior art documents disclose one or the other dispersed phase, it is the combination that applicant is claiming as novel. The Declaration does not provide evidence that applicant had possession of this invention prior to Tsai et al.

9. Regarding applicant's arguments that Obuchi et al. does not disclose or suggest an interlinking fastening component made from biodegradable resins, in col. 9, line 32, Obuchi et al. teach that tying materials may be molded from the resin. A tying material is used for fastening and, by definition, must interlock in some form or the other in order to tie.

It is noted that the features upon which applicant relies (i.e., "slide fasteners" and "complex fasteners represented by Figures") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The rejections are supported and are maintained.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER



KCE
August 4, 2003